

Appl. No. 09/688501
Appeal Brief

Customer No. 30223

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/688501
Applicant : Shridhar P. Joshi
Filed : October 16, 2000
Title : METHOD OF TRANSFERRING GAMING DATA ON A GLOBAL COMPUTER NETWORK
Conf. No. : 3225
Art Unit : 3714
Examiner : Alex P. Rada
Docket No. : 47079-00077

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF—PATENTS

U.S. Patent and Trademark Office

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Commissioner:

This Appeal Brief is filed pursuant to Applicant's appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 37-62. The due date for this Appeal Brief is May 6, 2006.

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I. REAL PARTY IN INTEREST

The real party in interest is WMS Gaming Inc., assignee of the above-referenced application, having a place of business at 3401 North California Avenue, Chicago, Illinois 60618.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board of Patent Appeals and Interferences in the present appeal.

III. STATUS OF CLAIMS

Currently pending 37-62 have been rejected and are the claims being appealed. Claims 1-36 have been cancelled. No claims have been allowed.

IV. STATUS OF AMENDMENTS

No amendments were filed after the final rejection. All previous claim amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Summary of Invention

Applicants' invention is generally directed to a remote gaming method in which players located outside a casino or gaming establishment may play gaming machines located inside the gaming establishment. *See, e.g., p. 3, lines 5-14.* As seen in FIG. 1, the remotely located players may access the gaming machines (160, 161, 162) by connecting to a casino web site (130) over the Internet (120) via a remote terminal (110). *See, e.g., p. 7, line 21 to p. 8, line 6.* The casino web site (130) receives randomly-generated outcome data from the gaming machines (160, 161, 162) through a casino server (140) and provides that outcome data to the remote terminal (110). *See, e.g., p. 13, line 3 to p. 14, line 14.* Each gaming machine (160, 161, 162) has uniquely identifying characteristics that allow the casino server (140) to distinguish data from that gaming machine (160, 161, 162) from other gaming machines. *See, e.g., p. 8, lines 23-25.*

To play, the remotely located players simply sign in to the casino web site (130) through the remote terminal (110) and specify one or more player preferences. *See, e.g., p. 13, lines 3-12.* The player preferences are then transmitted from the casino web site (130) to the casino server (140), which subsequently matches the player preferences to one or more wagering games/gaming machines (160, 161, 162) in the gaming establishment. *See, e.g., p. 13, lines 19-29.*

B. Summary of Independent Claim 37

Independent claim 37 is directed to a method of accessing a gaming site on a global computer network using a remote terminal. The method comprises, among other things, selecting a game of chance from a plurality of gaming machines located at a gaming establishment for remote play. The method further comprises placing a wager for playing the selected game via the remote terminal and receiving randomly-generated text or graphical outcome data at the remote terminal for the selected game. The outcome data is generated by one of the plurality of gaming machines at the gaming establishment and relayed to the gaming site through a gaming server.

C. Summary of Independent Claim 38

Independent claim 38 is directed to a remote gaming method that uses a gaming server a remote terminal, and a gaming site on a global computer network. The method comprises, among other things, randomly generating outcome data at one of a plurality of gaming machines communicatively coupled to the gaming server. The outcome data is generated for a game selected according to game selection information, the plurality of gaming machines being located at the gaming establishment. The method further comprises receiving the outcome data at the gaming server and transmitting the outcome data from the gaming server to the gaming site for display to the player on the remote terminal in text or graphical form.

The method of claim 38 differs from claim 37 in that it is from the perspective of the gaming establishment, whereas the method of claim 37 is from the perspective of the remote terminal.

D. Summary of Independent Claim 39

Independent claim 39 is directed to a method for playing a gaming machine located inside a gaming establishment from a remote terminal located outside the gaming establishment. The method comprises, among other things, establishing a communication link between the remote terminal and a gaming site on a global computer network. The gaming site is in communication with a gaming server for collecting outcome data from gaming machines located inside the gaming establishment. The method further comprises selecting a gaming machine at the gaming establishment using the remote terminal and making a wager to play the selected gaming machine. Outcome data, including game outcome, is received at the remote terminal resulting from a play of the gaming machine, and a payout is generated if the game outcome meets predetermined criteria.

The method of claim 39 differs from claims 37 and 38 in that it selects a particular gaming machine for remote play instead of a wagering game.

E. Summary of Independent Claim 52

Independent claim 52 is directed to a remote computer for the remote play of a local gaming machine located within a gaming establishment, the remote computer being located

outside the gaming establishment. The remote computer comprises a microprocessor, memory connected to the microprocessor and including instructions for controlling the microprocessor. The microprocessor is operative with the instructions in the memory to receive information identifying a plurality of local gaming machines located within the gaming establishment from a gaming server and to transmit data selecting at least one of the plurality of local gaming machines for remote play. The microprocessor is further operative with the instructions in the memory to receive a text or graphical outcome resulting from a local play of each the selected local gaming machine and generate a payout if the outcome meets predetermined criteria.

Claim 52 differs from the previous independent claims in that it is an apparatus claim, not a method claim.

F. Summary of Independent Claim 62

Independent claim 62 is also directed to a remote computer located outside a gaming establishment. The remote computer comprises means for receiving information identifying a plurality of local gaming machines each engaged in play within the gaming establishment and means for transmitting data from the remote computer for selecting at least one of the plurality of local gaming machines for information transfer. The remote computer further comprises means for receiving a text or graphical outcome resulting from a play of the selected local gaming machines and for generating a payout if the outcome meets predetermined criteria.

Claim 62 differs from claim 52 in that it is written in means-plus-function language and therefore, in accordance with 35 U.S.C. §112, sixth paragraph, must be interpreted to cover only the structures (and equivalents thereof) disclosed in the specification for performing the recited functions. For example, with respect to the “means for receiving information,” the recited function is receiving information identifying a plurality of local gaming machines, and the structure disclosed for performing that function is the remote terminal (110) and associated selection buttons, mouse (112), and/or keyboard (114). *See, e.g., p. 11, lines 27-30.* With respect to the “means for transmitting data,” the recited function is transmitting data from the remote computer for selecting at least one of the plurality of local gaming machines, and the structure disclosed for performing that function is the casino web site (130). *See, e.g., p. 13, lines 13-18.* As for the “means for receiving a text or graphical outcome” and “for generating a

payout," the recited functions are receiving a text or graphical outcome resulting from a play of the selected local gaming machines, and generating a payout if the outcome meets predetermined criteria, respectively. The disclosed structure for performing the recited functions is the casino server (140). *See, e.g., p. 14, lines 5-14; p. 15, lines 4-14.*

G. Summary of Dependent Claims 46, 47, 50, 56, and 57

Dependent claims 46 and 56 relate to an aspect of the invention where the outcome data includes a gaming machine type.

Claims 47 and 57 relate to an aspect of the invention where the outcome data includes player preferences.

Claim 50 relates to an aspect of the invention where the game outcome results from the gaming server initiating game play on the selected gaming machine.

As discussed below, each of these dependent claims includes subject matter that is not taught or suggested in the prior art.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 37-38 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Nos. 6,409,602 to Wiltshire et al. (“Wiltshire”) and 6,580,710 to Paravia et al. (“Paravia”).

Whether claims 39-62 are unpatentable under 35 U.S.C. § 103(a) over Wiltshire and U.S. Patent No. 6,001,016 to Walker (“Walker”).

VII. ARGUMENT

A. The Law of Obviousness

Obviousness requires that all the limitations of a claim must be taught or suggested by the combined prior art references. M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974)). A *prima facie* case of obviousness requires three basic criteria:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

M.P.E.P. § 2143 (citing *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991)).

Although a prior art reference may be modified to meet the claimed limitation, the resultant modified reference is not obvious unless the prior art also suggests or motivates the desirability of the modification. *In re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990) (citing *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Obviousness cannot "be established using hindsight or in view of the teachings or suggestions of the invention." *Ex parte Maguire*, 2002 WL 1801466, *4 (Bd. Pat. App. & Inter. 2002) (Appendix F) (quoting *Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.*, 73 F.3d 1085, 1087, 37 U.S.P.Q.2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996)). Further, the proposed modification cannot render the prior art "unsatisfactory for its intended purpose" nor can it "change the principle of operation" of a reference. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d at 902, 221 U.S.P.Q. at 1127 and *In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959)).

Obviousness also requires that a reference be considered as a whole, including those portions that teach away from the Applicant's claimed invention. See *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.3d 1540, 1550-51, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983) ("[T]he totality

of a reference's teaching must be considered."); *see also* M.P.E.P. § 2141.02 (stating that prior art must be considered in its entirety including disclosures that teach away from the claims). Indicia of teaching away in a reference gives insight into the question of obviousness. *Monarch Knitting Mach. Corp. v. Sulzer Morat GMBH*, 139 F.3d 877, 885, 45 U.S.P.Q.2d 1977, 1984 (Fed. Cir. 1998). A prior art reference may be considered to teach away when "a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *Monarch Knitting*, 139 F.3d at 885, 45 U.S.P.Q.2d at 1984 (quoting *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q. 1130, 1131 (Fed. Cir. 1994)).

B. Rejection of Claims 37 and 38 under 35 U.S.C. § 103

1. Wiltshire and Paravia do not teach or suggest remote play of a game of chance from a plurality of "gaming machines" in a gaming establishment.

A *prima facie* case of obviousness has not been established for claims 37 and 38 because Wiltshire and Paravia fail to teach or suggest remote play of a game of chance from a plurality of "gaming machines" in a gaming establishment. Such remote play allows players to play the game of chance without having to be present at the gaming establishment.

There are inherent advantages to being able to play a game of chance from an actual, real-life gaming machine in a gaming establishment without having to be present at the gaming establishment. For example, players may have a preference for the games of chance from gaming machines at a particular gaming establishment. Possibly, the players were very "lucky" during their last visit to the gaming establishment. The invention recited in claims 37 and 38 allows the players to play a game of chance from the very same gaming machines without having to be present at the gaming establishment.

Casino operators also benefit. As stated in the specification, resources are required to operate the gaming machines, including capital investment in each gaming machine, electricity to run the gaming machines, and maintenance of wear on the gaming machines resulting from game play. *See, e.g., p. 15, line 31 to p. 6, line 2.* By making existing gaming machines at the gaming establishment available to players located outside the casino, the casino operators can increase revenue without investing in new gaming machines. Moreover, the existing gaming machines

have already completed regulatory review and would not need to do so again for remote play, thus providing further cost savings to the casino operators.

None of the above benefits are available in Wiltshire. This is because Wiltshire does not teach or suggest remote play of a game of chance from a plurality of gaming machines in a gaming establishment. In contrast, Wiltshire teaches a computer gaming system involving a host/server computer connected to a plurality of remote client/terminal computers. *See, e.g., col. 3, lines 61-66.* One or more game programs are executed on the server/host computer for playing casino games. *See, e.g., col. 4, lines 35-38; col. 5, lines 45-50.* The one or more game programs generate casino game images that are then transferred from the server/host computer to the client/terminal computers. *See, e.g., col. 7, lines 18-22.* But while the computer gaming system of Wiltshire allows remote play of a game of chance, the game of chance comes from the server/host computer, not gaming machines in a gaming establishment.

Paravia also fails to teach or suggest remote play of a game of chance from a plurality of gaming machines in a gaming establishment. To the contrary, Paravia merely teaches a system for allowing players to place wagers on various sporting events over the Internet. *See, e.g., col. 9, lines 62-65.* Examples of such sporting events include basketball games, auto-racing events, to boating events, political polling results, jury trials, impeachment hearings, and the like. *See, e.g., col. 9, lines 25-42.* Such events involve a certain level of skill (i.e., the outcomes are not purely random because the player's knowledge influences their wager) and are therefore not considered by persons having ordinary skill in the art to be games of chance. Nowhere does Paravia teach or suggest remote play of games of chance, much less games of chance from gaming machines in a gaming establishment.

2. Wiltshire's "host/server computer" executing casino software is not functionally equivalent to "gaming machines" in a gaming establishment.

The Examiner attempts to gloss over the above differences between Wiltshire's host/server computer executing casino software and the claimed games of chance on a plurality of gaming machines in a gaming establishment by stating that the two are "functionally equivalent." *See, e.g., Office Action mailed November 2, 2005, p. 9, lines 10-19; Advisory Action Mailed January 25, 2006, p. 2, lines 9-17.* However, when viewed from a sufficiently broad

perspective, almost anything may be functionally equivalent to almost anything else. For example, an airplane is functionally equivalent to a hot air balloon in that both are machines capable of flight, but the two function on entirely different principles. Therefore, to establish a *prima facie* case of functional equivalency, the Examiner must comply with M.P.E.P. § 2144.06, reproduced in part below:

In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art**, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958).

(Emphasis added.)

In the present case, nothing in Wiltshire suggests that a host/server computer executing casino software is recognized in the prior art as functionally equivalent to games of chance on a plurality of gaming machines in a gaming establishment. Nor has the Examiner produced any other prior art evidence that a person of ordinary skill in the art recognizes such a functional equivalency. **Without this showing, Applicant respectfully submits there can be no basis for a rejection under functionally equivalency.**

Moreover, the invention recited in claims 37 and 38 operates on entirely different principles than the remote gaming system of Wiltshire. For example, the claimed invention is considered to be a “distributed” system insofar as each gaming machine generates its own outcome data. Therefore, each gaming machine must be uniquely identifiable from other gaming machines in order to avoid mixing the outcome data. *See, e.g., p. 8, lines 23-25.* The remote gaming system of Wiltshire, on the other hand, is considered to be a “centralized” system insofar as all outcome data is generated by the host/server computer. As such, an entirely different set of protocols is needed, one that does not include a unique identification for the host/server computer.

3. Summary of Arguments for claims 37 and 38.

Based on the foregoing, the Examiner’s position fails because (i) Wiltshire and Paravia do not teach or suggest remote play of a game of chance from a plurality of “gaming machines” in a gaming establishment, and (ii) Wiltshire’s “host/server computer” executing casino software

is not functionally equivalent to “gaming machines” in a gaming establishment. Accordingly, Applicant respectfully request withdrawal of the rejection of claims 37 and 38 under 35 U.S.C. § 103.

C. Rejection of Claims 39, 52, and 62 under 35 U.S.C. § 103

1. **Wiltshire and Walker fail to teach or suggest selecting a gaming machine within a gaming establishment from “a remote terminal located outside the gaming establishment.”**

A *prima facie* case of obviousness has not been established for claims 39, 52, and 62 for the reasons stated above with respect to claims 37 and 39, and also because Wiltshire and Walker fail to teach or suggest “selecting a gaming machine” in a gaming establishment from a remote terminal located outside the gaming establishment. Such an arrangement is particularly useful where a player located outside the gaming establishment has a preference for one or more of the gaming machines inside the gaming establishment, possibly because the player developed an emotional attachment to the gaming machine on a previous visit to the gaming establishment. For example, the gaming establishment may have 20 slot machines on its premises, and the player may have developed a preference for a particular one of these slot machines during his/her previous visit. The invention claimed in claims 39, 52, and 62 allows the player to select that particular slot machine for remote play after he/she leaves the gaming establishment.

As explained above, Wiltshire teaches a computer gaming system involving a host/server computer connected to a plurality of remote client/terminal computers. *See, e.g., col. 3, lines 61-66.* One or more game programs are executed on the server/host computer for playing casino games. *See, e.g., col. 4, lines 35-38; col. 5, lines 45-50.* The one or more game programs generate casino game images that are then transferred from the server/host computer to the client/terminal computers. *See, e.g., col. 7, lines 18-22.* The images illustrate various casino games supported by the computer gaming system. *See, e.g., col. 8, lines 49-51.*

Each of the available casino games is represented by an image of a “virtual button” that the player may actually play that casino game. *See, e.g., col. 8, lines 51-55.* But while the computer gaming system of Wiltshire allows players to select a casino game for remote play, **nowhere does Wiltshire even teach or suggest selecting a gaming machine,** much less selecting a gaming machine within a gaming establishment from a remote terminal located

outside the gaming establishment. Stated another way, Wiltshire does not distinguish between the individual gaming machines, such as slot machine A versus slot machine B (which may be the same type of slot machine), only the types of casino games, such as blackjack versus poker.

Walker also fails to teach or suggest selecting a gaming machine within the gaming establishment from a remote terminal located outside the gaming establishment. In Walker, multiple slot machines are in communication with a slot network server that, in turn, is in communication with a plurality of remote wagering terminals. *See, e.g., col. 3, line 60 to col. 4, line 2.* Each slot machine communicates outcome data to the slot network server, and the slot network server relays the outcome data to the remote wagering terminals. *See, e.g., col. 10, lines 31-35.*

However, Walker appears to teach that the remote wagering terminal is located right there on the premises of the gaming establishment. For example, Walker teaches that “each” remote wagering terminal has a hopper for dispensing coins. *See, e.g., col. 7, lines 54-56.* Such a hopper would need to be maintained and refilled from time to time with an appropriate amount of coins. It would be extremely difficult to effect such maintenance unless the remote wagering terminal was located right there on the premises. This positions is further supported by the statement in Walker that the player will be provided with a “map of all slots machines.” *See, e.g., col. 9, lines 36-38.* Such a map would only be useful if the player (hence, the remote wagering terminal) was right there on the premises. In addition, Walker teaches that the player is able to enter (on the remote wagering terminal) the ID number of each slot machine because each slot machine prominently displays an ID tag. *See e.g., col. 9, lines 33-38.* Clearly, the player (hence, the remote wagering terminal) must be on the premises with the slot machines in order to be able to see the ID tags. Thus, Walker fails to teach or suggest selecting a gaming machine within a gaming establishment from a remote terminal located outside the gaming establishment.

2. Wiltshire and Walker fail to teach or suggest “relaying outcome data” through a gaming site.

Wiltshire fails to teach or suggest relaying outcome data through a gaming site. The Examiner contends that the “website” in FIG. 3 of Wiltshire is a gaming site. *Office Action mailed November 2, 2005, p. 8, lines 6-11.* However, Wiltshire teaches very clearly that the

website is merely a software download site for downloading the client/terminal software. For example, Wiltshire states that once the software is installed on the client/terminal computer, the client/terminal computer connects to the host/server computer, not to the website. *See, e.g., col. 8, lines 27-31.* Nowhere does Wiltshire teach or suggest relaying outcome data through the website. Indeed, after its mention in col. 8, lines 27-31, the website is never referenced again throughout the remainder of Wiltshire.

Walker also fails to teach or suggest relaying outcome data through a gaming site. To the contrary, as can be seen in FIG. 1, Walker teaches that the remote wagering terminals are connected directly to the slot network server via a local area network. *See, e.g., col. 4, lines 2-5.* Indeed, a full text search of Walker for the term “website” or even just “site” returned zero hits.

3. Summary of Arguments for claims 39, 52, and 62.

Based on the foregoing, the Examiner’s position fails because (i) Wiltshire and Walker fail to teach or suggest selecting a gaming machine within a gaming establishment from a remote terminal located outside the gaming establishment, and (ii) Wiltshire and Walker fail to teach or suggest “relaying outcome data” through a gaming site. Accordingly, Applicant respectfully request withdrawal of the rejection of claims 39, 52, and 62 under 35 U.S.C. §103.

D. Rejection of Claims 46, 47, 50, 56, and 57 under 35 U.S.C. § 103

1. Walker fails to teach or suggest outcome data that includes a “gaming machine type,” as required by claims 46 and 56.

A *prima facie* case of obviousness has not been established against dependent claims 46 and 56 because Walker fails to teach or suggest outcome data that includes a gaming machine type. For example, Walker teaches that the outcome data may include whether the player has won or lost, the amount won (if any), the amount of lost (if any), and the visual representation of the outcome of a play on the slot machine, such as the positions of the reels. *See, e.g., col. 4 lines 13-17. However, nowhere does Walker teach or suggest that the outcome data may include a gaming machine type.*

2. Walker fails to teach or suggest outcome data that includes “player preferences,” as required by claims 47 and 57.

A *prima facie* case of obviousness has also not been established against dependent claims 47 and 57 because Walker fails to teach or suggest outcome data that includes player preferences. As mentioned above, Walker teaches outcome data that may include whether the player has won or lost, the amount won (if any), the amount lost (if any), and the visual representation of the outcome of a play on the slot machine, such as the positions of the reels. *See, e.g., col. 4 lines 13-17. However, nowhere does Walker teach or suggest that the outcome data may include player preferences.*

3. Walker fails to teach or suggest a gaming server initiating game play, as required by claims 50.

Finally, a *prima facie* case of obviousness has not been established against dependent claim 50 because Walker fails to teach or suggest the gaming server initiating game play on the selected gaming machine. For example, Walker teaches that the slot network server selects slot machines that are currently being play by players physically present at the slot machines for remote play in order to obtain live outcome data. *See, e.g., col. 10, lines 16-19.* Therefore, the players physically present at the slot machines are the ones whc initiate game play, not the slot network server. The slot network server simply taps into the live outcome data from the slot machines and relays that data to the remote wagering terminals.

VIII. CLAIMS APPENDIX

A copy of the currently pending claims is attached as Appendix A.

IX. EVIDENCE APPENDIX

Copies of the Wiltshire, Paravia, and Walker patents are attached as Appendices B, C and D, respectively. A copy of an Office Action mailed November 2, 2005, finally rejecting the claims is attached as Appendix E. A copy of an Advisory Action mailed January 25, 2006, maintaining the rejections is attached as Appendix F.

X. RELATED PROCEEDINGS APPENDIX

None.

CONCLUSION

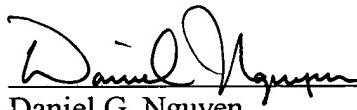
For at least the foregoing reasons, the final rejection of all the appealed claims should be reversed.

A check in the amount of \$500.00 is enclosed herewith as required by 37 C.F.R. § 41.20(b)(2) for filing this Appeal Brief. The Commissioner is authorized to charge any additional fees inadvertently omitted that may be required (except the issue fee) now or during the pendency of this application to JENKENS & GILCHRIST, P.C. Deposit Account No. 10-0447 (47079-00077).

The PTO did not receive the following listed item(s) a check for \$500.-

Date: May 8, 2006

Respectfully submitted,



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TRANSMITTAL OF APPEAL BRIEF

Docket No.
47079-00077USPT

In re Application of: Shridhar P. Joshi

Application No. 09/688501	Filing Date October 16, 2000	Examiner A. P. Rada	Group Art Unit 3714
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Invention: METHOD OF TRANSFERRING GAMING DATA ON A GLOBAL COMPUTER NETWORK

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: March 6, 2006.

The fee for filing this Appeal Brief is \$ 500.00.

Large Entity Small Entity

A petition for extension of time is also enclosed.

The fee for the extension of time is _____.

A check in the amount of _____ is enclosed.

Charge the amount of the fee to Deposit Account No. 10-0447.
This sheet is submitted in duplicate.

Payment by credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any additional fees that may be required or
credit any overpayment to Deposit Account No. 10-0447.
This sheet is submitted in duplicate.

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Dated: May 8, 2006

APPENDIX A – CLAIMS ON APPEAL

Claims 1-36. (Cancelled)

37. (Previously Presented) A remote gaming method comprising:
accessing, via a remote terminal, a gaming site on a global computer network connected
to said remote terminal;
providing, via said remote terminal, personal identification information to said gaming
site;
selecting, via said remote terminal, a game of chance from a plurality of gaming machines
located at a gaming establishment for remote play, said remote terminal being
located outside said gaming establishment;
placing, via said remote terminal, a wager for playing said selected game; and
receiving randomly-generated text or graphical outcome data at said remote terminal for
said selected game, said outcome data being generated by one of said plurality of
gaming machines at said gaming establishment and relayed to said gaming site
through a gaming server connected to said gaming site.

38. (Previously Presented) A remote gaming method using a gaming server, a remote terminal, and a gaming site on a global computer network, said gaming server being located at a gaming establishment, said remote terminal being located outside said gaming establishment, said gaming site being provided on said global computer network, the method comprising:

receiving, at said gaming server, personal identification information, game selection information, and wager information from a player accessing said gaming site via said remote terminal, said remote terminal being connected to said global computer network;

randomly generating outcome data at one of a plurality of gaming machines communicatively coupled to said gaming server, said outcome data being generated for a game selected according to said game selection information, said plurality of gaming machines being located at said gaming establishment;

receiving said outcome data at said gaming server; and

transmitting said outcome data from said gaming server to said gaming site for display to said player on said remote terminal in text or graphical form.

39. (Previously Presented) A method for playing a gaming machine located inside a gaming establishment from a remote terminal located outside the gaming establishment comprising:

establishing a communication link between said remote terminal and a gaming site on a global computer network, said gaming site in communication with a gaming server for collecting outcome data from gaming machines located inside the gaming establishment;

selecting a gaming machine at said gaming establishment using said remote terminal;

making a wager to play the selected gaming machine;

receiving outcome data, including game outcome, at said remote terminal resulting from a play of said gaming machine; and

generating a payout if said game outcome meets predetermined criteria.

40. (Previously Presented) The method of claim 39 wherein said outcome data comprises information identifying the value of said payout; and further comprising the step of using said payout information to simulate a display of said game outcome at said remote location.

41. (Previously Presented) The method of claim 39 further comprising using said outcome data to simulate a display of said game outcome on said remote terminal.

42. (Previously Presented) The method of claim 39, wherein said selected gaming machine comprises a slot machine and wherein said game outcome data includes a reel position.

43. (Previously Presented) The method of claim 39 wherein said selected gaming machine comprises a video poker machine including a display for displaying a poker hand.

44. (Previously Presented) The method of claim 39 wherein said step of receiving outcome data includes receiving outcome data from a plurality of gaming machines for remote play.
45. (Previously Presented) The method of claim 44 wherein said step of receiving outcome data includes receiving a gaming machine identifier.
46. (Previously Presented) The method of claim 44 wherein said step of receiving outcome data includes receiving a gaming machine type.
47. (Previously Presented) The method of claim 44 wherein said step of receiving outcome data includes receiving player preferences.
48. (Previously Presented) The method of claim 39 wherein said selected gaming machine comprises a slot machine and wherein said game outcome comprises information identifying a reel position of said gaming machine; and further comprising the step of using said outcome information to display said reel position on said remote terminal.
49. (Previously Presented) The method of claim 39 and further including the steps of receiving a player identifier; and transmitting said player identifier for identification of said player.
50. (Previously Presented) The method of claim 39 wherein said game outcome results from the server initiating game play on the selected gaming machine.
51. (Previously Presented) The method of claim 39 wherein said game outcome results from the manual game play on the selected gaming machine.

52. (Previously Presented) A remote computer for the remote play of a local gaming machine located within a gaming establishment and connected to a gaming server, the remote computer being located outside said gaming establishment, said remote computer connected to a gaming site through a global computing network served by said gaming server, said remote computer comprising:

a microprocessor;

memory connected to said microprocessor and including instructions for controlling said microprocessor; and

said microprocessor being operative with said instructions in said memory to:

receive information identifying a plurality of local gaming machines located within said gaming establishment from a gaming server;

transmit data selecting of at least one said plurality of local gaming machines for remote play;

receive a text or graphical outcome resulting from a local play of each said selected local gaming machine; and

generate a payout if said outcome meets predetermined criteria.

53. (Previously Presented) The remote computer of claim 52 wherein said selected gaming machine comprises a slot machine and wherein said outcome includes a reel position.

54. (Previously Presented) The remote computer of claim 52 wherein said operation of receiving information includes receiving information selecting at least two of said plurality of local gaming machines for remote play.

55. (Previously Presented) The remote computer of claim 52 wherein said operation of receiving information includes receiving a gaming machine identifier.
56. (Previously Presented) The remote computer of claim 52 wherein said operation of receiving information includes receiving a gaming machine type.
57. (Previously Presented) The remote computer of claim 52 wherein said operation of receiving information includes receiving player preferences.
58. (Previously Presented) The remote computer of claim 52 wherein said selected gaming machine comprises a video poker machine including a display for displaying a poker hand.
59. (Previously Presented) The remote computer of claim 52 wherein said outcome comprises data identifying the value of said payout; and further comprising the operation of using said payout data to simulate a display of said outcome at said remote location.
60. (Previously Presented) The remote computer of claim 52 wherein said outcome comprises information identifying a reel position of said selected gaming machine; and further comprising the operation of using said outcome data to display said reel position at said remote location.
61. (Previously Presented) The remote computer of claim 52 further including the operations of: receiving a player identifier; and transmitting said player identifier for identification of said player.

62. (Previously Presented) A remote computer located outside a gaming establishment, said gaming establishment having a plurality of gaming machines linked by a gaming server, said remote computer connected to a gaming site through a global computing network served by said gaming server comprising:

means for receiving information identifying a plurality of local gaming machines each engaged in play within said gaming establishment;

means for transmitting data from said remote computer for selecting at least one of said plurality of local gaming machines for information transfer;

means for receiving a text or graphical outcome resulting from a play of said selected local gaming machines; and

for generating a payout if said outcome meets predetermined criteria.

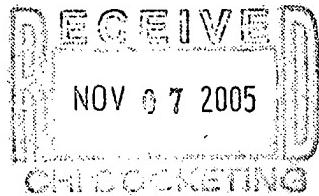


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,501	10/16/2000	Shridhar P. Joshi	47079-00077	3225

30223 7590 11/02/2005
JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606



EXAMINER
RADA, ALEX P

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED

INIT. JR DATE: 11/8/05
Resp. to Krautke
ACTION: DATE: 1/2/06
Final Rej. Due 2/2/06
Final Rej. Deadline 5/2/06

Office Action Summary	Application No.	Applicant(s)
	09/688,501	JOSHI, SHRIDHAR P.
	Examiner Alex P. Rada	Art Unit 3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 July 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 37-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 37-62 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

In response to the amendment filed July 25, 2005 in which the applicant had previously canceled claims 1-21, and 35-36, cancels claims 22-34, submits arguments and claims 37-62 are pending in this application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiltshire et al. (US 6,409,602) in view of Paravia et al. (US 6,508,710).
3. Wiltshire et al discloses the following:

Accessing via a remote terminal (client/terminal), a gaming site (310 of figure 3) on a global computer network (column 8, lines 15-34) connected to the remote terminal (client/terminal), selecting a game of chance from a plurality of gaming machine located at a gaming establishment for remote play (figures 4b-9D), the remote terminal being located outside the gaming establishment, placing a wager for playing the selected game and receiving randomly-generated text or graphical outcome data at the remote terminal for the selected game the outcome data being generated by one of the plurality of gaming machines at the gaming establishment and relayed to the gaming site through a gaming server connected to the gaming site,

in which the examiner interprets the server/host containing the different programs and data of the different chance game to be a functional equivalent to placing a wager for playing the selected game and receiving randomly-generated text or graphical outcome data at the remote terminal for the selected game the outcome data being generated by one of the plurality of gaming machines at the gaming establishment and relayed to the gaming site through a gaming server connected to the gaming site (column 7, lines 7-56 and figures 2-3) as recited in claims 37-38.

Wiltshire et al does expressly disclose the following:

Providing via the remote terminal, personal identification information to the gaming site as recited in claims 37-38.

Paravia et al teaches the following:

Providing via the remote terminal, personal identification information to the gaming site (column 6, lines 49-55 and item 142 of figure 2) as recited in claims 37-38. By having providing personal identification information to the gaming site, one of ordinary skill in the art would provide a verification and permission to game players that are permitted to play.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Wiltshire et al to include personal identification information to the gaming site as taught Paravia et al to provide a verification and permission to game players that are permitted to play.

4. Claims 39-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiltshire et al. (US 6,409,602) in view of Walker et al. (US 6,001,016).

5. Wiltshire et al discloses the following:

Establishing a communication link between the remote terminal (client/terminal) and a gaming site (310 of figure 3) on a global computer network (column 8, lines 15-34), the gaming site in communication with a gaming server (server/host), selecting a gaming machine (figures 4B-9D) at the gaming establishment using the remote terminal, making a wager to play the selected gaming machine, receiving outcome data, including game outcome at the remote terminal resulting from a play of the gaming machine (figures 4B-9D), and generating a payout if the game outcome meets predetermined criteria (figure 4B, column 7, lines 7-56, and column 8, lines 15-34) as recited in claim 39.

The game outcome resulting from the server initiating game play on the selected gaming machine (column 8, lines 42-65) as recited in claim 50.

The remote computer having a microprocessor, memory connected to the microprocessor and including instruction s for controlling the microprocessor, and the microprocessor being operative with the instructions in the memory to receive information identifying a plurality of local gaming machine located within the gaming establishment from a gaming server, receive a text or graphical outcome resulting from a local play of each of the selected gaming machines and generate payout if the outcome meets predetermined criteria (figures 4B-9D, column 6, line 44 – column 7, line 6, column 7, lines 7-56, and column 8, lines 15-34) as recited in claim 52.

The gaming server having means for receiving information identifying a plurality of gaming machines (figures 4B-9D) each engaged in play within the gaming establishment, means for receiving a text or graphical outcome resulting from a play of the selected gaming machines and means for generating a payout if the outcome

meets predetermined criteria (figures 4B-9D, column 6, line 44 – column 7, line 6, column 7, lines 7-56, and column 8, lines 15-34) as recited in claim 62.

Wiltshire et al does not expressly disclose the following:

The gaming server collecting outcome data from the gamine machines located inside the gaming establishment as recited in claims 39, 52 and 62.

The outcome data having information identifying the value of the payout and simulate a display of the game outcome at the remote location as recited in claims 40 and 59.

The outcome data to simulate a display of the game outcome on the remote terminal as recited in claim 41.

The selected gaming machine is a slot machine wherein the outcome data includes reel position as recited in claims 42, 48, 53, and 60.

The selected gaming machine is a video poker machine including a display for displaying a poker hand as recited in claims 43 and 58.

The receiving outcome data includes receiving outcome data from a plurality of gaming machine form remote play as recited in claim 44.

The outcome data includes a gaming machine identifier and gaming machine type as recited in claim 45-46 and 55-56.

The outcome data including receiving player preferences as recited in claims 47 and 57.

A player identifier and transmitting the player identifier for identification of the player as recited in claims 49 and 61.

Walker et al teaches the following:

The gaming server collecting outcome data from the gaming machines located inside the gaming establishment (figure 1) as recited in claims 39, 52 and 62.

The outcome data having information identifying the value of the payout and simulate a display of the game outcome at the remote location (column 5, lines 33-37) as recited in claims 40 and 59.

The outcome data to simulate a display of the game outcome on the remote terminal (column 5, lines 33-37) as recited in claim 41.

The selected gaming machine is a slot machine wherein the outcome data includes reel position (column 5, lines 33-37) as recited in claims 42, 48, 53-54, and 60.

The selected gaming machine is a video poker machine including a display for displaying a poker hand (column 5, lines 33-37) as recited in claims 43 and 58.

The receiving outcome data includes receiving outcome data from a plurality of gaming machine form remote play (column 6, lines 45-56) as recited in claim 44.

The outcome data includes a gaming machine identifier and gaming machine type (figure 5 and column 6, lines 31-44) as recited in claim 45-46 and 55-56.

The outcome data including receiving player preferences (column 6, lines 8-30) as recited in claims 47 and 57.

A player identifier and transmitting the player identifier for identification of the player (column 6, lines 8-30) as recited in claims 49 and 61.

The outcome results from the manual game play on the selected gaming machine (summary) as recited in claim 51. By transmitting data from the gaming machine located in the gaming establishment, one of ordinary skill in the art would

provide a system that does not require human intervention and live video transmission of the game being played.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Wiltshire et al to include the gaming server collecting outcome data from the gaming machines located inside the gaming establishment, the outcome data having information identifying the value of the payout and simulate a display of the game outcome at the remote location, the outcome data to simulate a display of the game outcome on the remote terminal, the selected gaming machine is a slot machine wherein the outcome data includes reel position, the selected gaming machine is a video poker machine including a display for displaying a poker hand, the receiving outcome data includes receiving outcome data from a plurality of gaming machine form remote play, the outcome data includes a gaming machine identifier and gaming machine type, the outcome data including receiving player preferences, and a player identifier and transmitting the player identifier for identification of the player as taught by Walker et al to provide a system that does not require human intervention and live video transmission of the game being played.

Response to Arguments

6. Applicant's arguments filed July 25, 2005 have been fully considered but they are not persuasive.

Applicant contends that the Wiltshire reference lacks a gaming site and the "access website" in figure 3 is merely a software download site for downloading the installation software. Once the

software is installed, the website 310 contribute nothing else to Wiltshire (i.e., provides no gaming data or information to the client/terminal). The Wilshire reference does not disclose the user of two separate intermediate nodes – a gaming server and a gaming site – between the gaming machines and the remote gaming terminal. The outcome data from the gaming machine passes through two separate intermediate noted before arriving at the gaming terminal.

In response the Wiltshire reference does disclose a gaming site (website) in figure 3, item 310. Wiltshire discloses in col. 8, lines 15-34 that a user accesses a website (gaming site) using a web browser such as Internet Explorer, Netscape Navigator or the like and downloads the program from the website (gaming site). The gaming data or information to the client/terminal is executed from the server/host computer, which updates the state (randomly-generated or graphical outcome data) of the game accordingly (col. 7, lines 7-44 and figure 2).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., two separate intermediate nodes, a real gaming machine) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Wiltshire reference does disclose data passing through two separate intermediate nodes. Figure 1A discloses a first node being the network interface (115), which may access the Internet or a particular website on the Internet and the second node is the server/host (110).

Applicant contends that the host/server computer executing casino game programs is not a functionally equivalent to the gaming machines in a gaming establishment. Any evidence from Wiltshire or any other art recognizes a virtual gaming machine to be functionally equivalent to a gaming machine in a gaming establishment.

In response to applicant's arguments that the host/server computer executing casino game programs is not a functional equivalent to a gaming machine in a gaming establishment, it is noted that a gaming machine at a gaming establishment is just a computer that runs a program either on the gaming machine or communication to a server like in Walker (6,001,016), Karmarkar (6,508,709), and Paravia (6,508,710) to name a few. Since a physical embodiment of various games have been re-implemented into microcomputer-based video gaming stations for the last 20 years (Wiltshire-background), it is obvious to a person of ordinary skill in the art would recognize that gaming machine can be re-implemented into a video gaming system, which is nothing more than a cabinet having a monitor, a program either on the gaming machine or communication to a server, and some means of accepting and dispensing wagers. When a gaming machine calculates the game results on the gaming machine at a gaming site, the functional equivalent to that would be a gaming machine running a program and the calculations are carried out on a sever located at a gaming site and routed back to the gaming machine at the gaming site. The only difference is the gaming results are calculated on the server and communicated back to the gaming machine instead of calculating the gaming results at the gaming machine itself. If you take the same computer based video gaming machine and place that video game program on a home PC, the only things that have changed are how the program (results and calculations) are being communicated and how wagers are accepted and payouts awarded. Therefore, a host/server computer executing a casino game program is functionally equivalent to a gaming machine in a gaming establishment.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

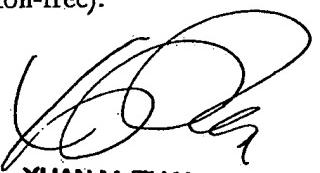
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APR
APR

571-273-4452


XUAN M. THAI
SUPERVISORY PATENT EXAMINER

TC3700

Notice of References Cited		Application/Control No.	Applicant(s)/Patent Under Reexamination	
		09/688,501	JOSHI, SHRIDHAR P.	
Examiner		Art Unit		Page 1 of 1
Alex P. Rada		3713		

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,409,602	06-2002	Wiltshire et al.	463/42
	B	US-6,508,710	01-2003	Paravia et al.	463/42
	C	US-6,001,016	12-1999	Walker et al.	463/42
	D	US-6,508,709	01-2003	Karmarkar, Jayant S.	463/42
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
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	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

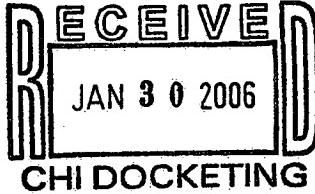


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,501	10/16/2000	Shridhar P. Joshi	47079-00077	3225

30223 7590 01/25/2006
JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606



EXAMINER
RADA, ALEX P

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED
INIT. JR DATE: 1/30/06
Resp. Due 2/2/06
ACTION: AA Deadline 5/2/06

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/688,501	Applicant(s) JOSHI, SHRIDHAR P.
	Examiner Alex P. Rada	Art Unit 3713

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) They raise the issue of new matter (see NOTE below);
 - (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. Applicant's reply has overcome the following rejection(s): _____.
6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 37-62

Claim(s) withdrawn from consideration: _____

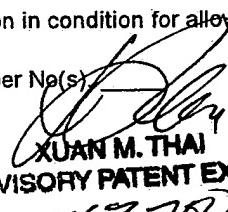
AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

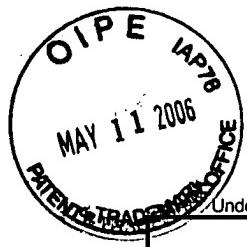
11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) _____
13. Other: _____


XUAN M. THAI
SUPERVISORY PATENT EXAMINER
TC3700

Continuation of 11. does NOT place the application in condition for allowance because: Applicant contends that the claimed invention is directed toward a remote gaming method and a computer therefore, where players at gaming terminal located outside a gaming establishment may play gaming machines located inside the gaming establishment.

The definition of the word "remote" is separated by an interval or space greater than usual. Wiltshire discloses communication pathways that are remote having any type of local area, wide area, or global communication pathways, including the Internet and the World Wide Web (col. 5, lines 31-33). Thus Wiltshire is capable of a remote gaming method and a computer, where players at gaming terminals located outside (remote) a gaming establishment playing gaming machines located inside the gaming establishment. Applicant contends that the examiner has failed to meet the standard for raising a functionally equivalent rejection.

The examiner notes that the statement used in the office action on page 9, lines 5-8 was to make a point that physical gaming machines were re-introduced as video based gaming machine, which is very common and very well known in industry today. As noted in the Final office action, when a gaming machine calculates the game results on the gaming machine at a gaming site, the functional equivalent to that would be a gaming machine running a program and the calculations are carried out on a server located at a gaming site and routed back to the gaming machine at the gaming site. The only difference is the gaming results are calculated on the server and communicated back to the gaming machine instead of calculating the gaming results at the gaming machine itself. If you take the same computer based video gaming machine and place that video game program on a home PC, the only things that have changed are how the program (results and calculations) are being communicated and how wagers are accepted and payouts awarded. Therefore, a host/server computer executing a casino game program is functionally equivalent to a gaming machine in a gaming establishment..



PTO/SB/92 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Application No. (if known): 09/688501

Attorney Docket No.: 47079-00077

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Appeal Brief Transmittal (1 page)
Appeal Brief (23 pages)
Appendices A-F